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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/510,671 | 10/06/2004 | Takayoshi Fujino | 57545US004 | 3912 |
| 32692 | 7590 | 07/20/2006 | EXAMINER | |
| 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427 | | | CHAN, SING P | |
| | | ART UNIT | PAPER NUMBER | |
| | | | 1734 | |

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/510,671 | FUJINO, TAKAYOSHI | |
| | Examiner | Art Unit | |
| | Sing P. Chan | 1734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-11 and 14-19 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 October 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 12 and 13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly submitted claims are directed to a process for applying an adhesive tape, whereas the originally filed claims are directed to an adhesive tape application tool.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12 and 13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 4, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 2, it is unclear what is meant by "second guide roller is movable in a central axis direction." For the purpose of examination, "second guide roller is movable by rotating about a central axis" will be assumed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-10 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinozaki et al (WO 01/25077).

Regarding claims 1-9, Shinozaki et al discloses an apparatus for applying a tape to door sash frame. The apparatus includes an elastic roller (9), guide elements of pinching nip rollers (11a, 11b, and 11c), which the rollers includes a tapered surface or rounded edges, and the rollers are oriented in opposing direction and contacting the opposite sides of a projected line portion of the door sash frame (See US equivalent patent 6,748,993, Col 6, lines 38-59 and Figures 12 and 13), and a grip (6) ad projection (8), which can be held by fingers to move the holding piece (3) away from the second holding piece (4) to either engage or disengage the door sash frame (See US equivalent patent 6,748,993, Col 5, lines 44-52 and Figure 2) Furthermore, Shinozaki et al shows the rollers have a first diameter and a second diameter smaller than the first diameter from the center to the end of the rollers, which located between the first and second end of the rollers.

Regarding claims 14-18, Shinozaki et al discloses an apparatus for applying a tape to door sash frame. The apparatus includes an elastic roller (9), guide elements of

pinching nip rollers (11a, 11b, and 11c), which the rollers includes a tapered surface, and the rollers are oriented in opposing direction and contacting the opposite sides of a projected line portion of the door sash frame. (See US equivalent patent 6,748,993, Col 6, lines 38-59 and Figures 12 and 13)

Regarding claims 10 and 19, Shinozaki et al discloses the nip rollers includes through hole in each roller, which is cylindrical and located together with the tapered portion between the first and second end of the rollers. (See Figures 15, 17, and 18)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinozaki et al (WO 01/25077) as applied to claim 1 above, and further in view of Fujiwara (JP 2000-159212).

Shinozaki et al discloses the nip rollers also included cylindrical rollers as the nip rollers as well as rollers with rounded edges or tapered edges. (See Figures 2 and 3) Shinozaki et al is silent as to the rollers includes frustoconical shape. However, providing frustoconical shape rollers as the guide rollers is well known and conventional as shown for example by Fujiwara. Fujiwara discloses an apparatus for applying adhesive tape to T-mold member. The apparatus includes guide rollers, which are

either frustoconical shape or cylindrical. (See English Machine translation of JP 2000-159212, Paragraph 2 and Figures 4, 5, 8 and d11)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide either a cylindrical, rounded, or frustoconical shaped guide rollers as disclosed by Fujiwara in the apparatus of Shinozaki et al, which they are all equivalents.

Response to Arguments

9. Applicant's arguments with respect to claims 1-11 and 14-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Chan Sing P
SPC

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